



Docket No.: 229752000701
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Design Application of:
Paul Z. ZIMMET

Application No.: 10/067,832

Confirmation No.: 3004

Filed: June 3, 2002

Art Unit: 1647

For: NOVEL GENE AND USES THEREFOR

Examiner: J. Seharaseyon

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed September 9, 2005, Applicant hereby provisionally elects claims 7-10 (Group II) for examination, with traverse. Applicants also note that in the Office Action mailed on September 9, 2005, the Examiner identified Group I as including claims 1-6. In a preliminary amendment filed concurrently with this application, claims 1-6 were cancelled. Thus, the Office Action should have reflected that claims 7-19 are pending in this application.

Applicants respectfully traverse the restriction requirement of claims identified in Group II and Group III. The claims of Group III relate to a method of treatment employing the composition of Group II. As such, the invention of Group III cannot be practiced in the absence of the invention of Group II. *See MPEP 806.04(B)* (restriction between a process and apparatus is only proper where the process and apparatus are distinct from one another). Further, pursuant to MPEP 805.06(e), at least one-way distinctness is required to support restriction of a product from the process of using that product. Here, there is neither.

The invention of Group II is designed for use in accordance with the process of Group III. The invention of Group II, as described in the specification, is not contemplated for use with any materially different process other than that of Group III. As described in the specification


As well, the process of Group III is not contemplated for use with a product other than the proteins of Group II, as evidenced by the fact that the claims of Group III depend from the claims of Group II, thereby including the proteins of Group II within the scope of the process itself. For this reason, there is no distinctiveness between the claims of Groups II and III and the Examiner should withdraw the requirement for restriction between these groups.

In the unlikely event that the transmittal form is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing **229752000701**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: November 9, 2005

Respectfully submitted,

By


Wayne C. Jagschke, Jr.

Registration No.: 38,503
MORRISON & FOERSTER LLP
1650 Tysons Blvd, Suite 300
McLean, Virginia 22102
(703) 760-7756